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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/587,448	12/01/1995	TSE HO KEUNG		4610

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TSE HO KEUNG
RM 1535, TAI ON LAU
SAI WAN HOI
SHAUKIEWAN,
HONG KONG

EXAMINER

BARRON JR, GILBERTO

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 12/02/2002

#52

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/587,448

Applicant(s)

HO KEUNG, TSE

Examiner

Gilberto Barrón Jr.

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____.

Response to Amendment

1. The Amendment filed November 5, 2002 has been carefully considered but is not persuasive in overcoming the rejections set forth in the Office Action mailed September 13, 2002. A response to Applicant's arguments followed by the grounds of rejection appears below.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

3. Applicant argues that Haas necessitates that the rightful user's credit card number be displayed on the screen, while Applicant's claim do not require this feature. However, it is the claims that are to distinguish from the prior art and not that the prior art operates differently. Claim 12 (as amended) recites "verifying said account, by an electronic transaction system, " this is shown in Haas at column 3, lines 55-60. Further, claim 12 is directed to a method of verifying identity of a user and not for protecting or authorizing software on data processing apparatus.

Claim Rejections - 35 USC § 112

4. Claims 2-7, 9-11 and 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 12 have been amended without regard for the recitations of the dependent claims.

Double Patenting

3. Claims 1-7 and 9-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of co-pending Application No. 09/117,276. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-7 and 9-21 of this application are of the same scope as claims 1-22 of the continuation application. The subject matter of application claims 1-7 and 9-21 is obvious from the subject matter of co-pending claims 1-22, i.e. there does not appear to be any substantial difference between the claims in the parent application and this application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Applicant is advised that abandonment of the co-pending application is not required, but would obviate this double patenting rejection and would not require relinquishing the priority date established by the parent. A terminal disclaimer in this application would also obviate this double patenting rejection and does not require abandonment or relinquishing priority date. In either case, withdrawal of priority date is not required.

Claim Rejections - 35 USC § 112

5. Claims 1-7 and 9-21 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The claims of this application continue to be indefinite. Applicant's chose of alternative expressions and narrative dialog impede the formation of a claim that

positively sets forth the element that comprises Applicant's invention. Applicant is requested to provide a clean set of claims that eliminate language that merely serves to explain rather than set forth the elements and their respective functions.

Claims 9-11, 13-15 and 19-21 are indefinite because they recite the same elements without clarifying what embodiment is being set forth, for example, it is not clear there is any difference in claim 13 from claim 15.

Claim Rejections - 35 USC § 103

6. Claims 1, 2, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedemer (4,796,181) in view of Haas et al (5,719,938 issued February 17, 1998, filing date August 1, 1994).

The Wiedemer patent provides for an identity means to determine authorization if a user and provides for information that leads to a billing charge, but does not disclose the step of not causing an operation for which an authorized user is responsible for .

The patent to Haas teaches a method for providing secure access to shared information such as a newspaper, see column 1, lines 20-35. The Haas patent teaches deterrents for discouraging users from providing useful information to others to access the information in question. Column 5, lines 47-54 teach a first deterrent as causing a rightful user's credit card number to display to discourage a rightful user from sharing the information to access the secured information to others.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Wiedemer method as taught in Haas by causing a

rightful user's credit card number to be displayed in order to discourage rightful user's from sharing information with others who are not the rightful user(s).

The limitations of claim 2 that recites the authentication of the identity software is met by the operation of "checking that the external code and the internal code on the security module which are unique to any individual user are correct", see column 7, lines 15-46 of Wiedemer.

7. Claims 9-11, 13-15 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedemer (4,796,181) in view of Haas et al (5,719,938 issued February 17, 1998, filing date August 1, 1994) as applied to claim 1 above, and further in view of Cooper (5,737,416).

Claims 9-11, 13-15 and 19-21 provide for the protected software to include validating information for identity information and encrypted identity information. The identity information and the encrypted information are to be compared to determine validity of the protected software. Wiedemer discloses an identity means to determine authorization if a user and provides for information that leads to a billing charge, but does not disclose the step of not causing a charge or electronic commerce operation to be performed. Further, Wiedemer does not describe the application information as providing the validation information or the authentication of the computer.

The Cooper patent is a system for allowing trial period use of software. The system provides protected software to be used if certain access conditions are met. Figure 32 shows that the system uses machine ID, including customer information to be part of a file that must be present and validated for access to the protected software.

Figure 24 shows that the protected software includes encrypted validation information for checking the integrity of the information used to determine validity. Column 20, lines 1-19 and col. 23, lines 3-16 describe the use of the machine ID to authenticate the computer and that use of the encrypted validity information to validate the identity information.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiedemer as taught in Cooper by use of a machine ID to authenticate the computer and of the encrypted validity information to validate the identity information in order to authenticate not only the user but the computer that is being used.

Haas teaches a method for providing secure access to shared information such as a newspaper, see column 1, lines 20-35. The Haas patent teaches deterrents for discouraging users from providing useful information to others to access the information in question. Column 5, lines 47-54 teach a first deterrent as causing a rightful user's credit card number to display to discourage a rightful user from sharing the information to access the secured information to others.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Wiedemer method as taught in Haas by causing a rightful user's credit card number to be displayed in order to discourage rightful user's from sharing information with others who are not the rightful user(s).

8. Claims 3-7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedemer (4,796,181) in view of Haas et al (5,719,938 issued February 17, 1998,

filing date August 1, 1994) as applied to claim 1 above, and further in view of Hellman (4,658,093).

The Wiedemer and Haas references do not teach authentication of the command from a remote computer and determining the configuration of the computer. However, the Hellman teaches sending of an authorization command from a remote computer that allows the user to implement software if the configuration of the computer is correct, see column 8, line 61 thru column 9, line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Wiedemer reference to allow for authentication of the remote computer command and determine whether the proper computer is being authorized as taught in Hellman in order to limit the authorized software to a specific computer.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilberto Barrón Jr. whose telephone number is (703) 305-1830. The examiner can normally be reached on Mondays thru Thursdays from 8:00 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, either Mr. Albert Decady, who can be reached on (703) 305-9595, or Ms. Gail Hayes, who can be reached on (703) 305-9711, may be contacted for assistance.

The fax phone number for OFFICIAL responses for the organization where this application or proceeding is assigned is (703) 746-7239.

The fax phone number for AFTER FINAL responses for the organization where this application or proceeding is assigned is (703) 746-7238.

The fax phone number for DRAFT proposals for the organization where this application or proceeding is assigned is (703) 746-7240

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

GILBERTO BARRÓN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100